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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,708	09/07/2004	Louis T. Klauder JR.	BENDS2	3553

7590 10/13/2005

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EXAMINER

FREJD, RUSSELL WARREN

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/506,708	Applicant(s) KLAUDER, LOUIS T.	
	Examiner Russell Frejd	Art Unit 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12.13.04, 1.18.05</u> | 6) <input type="checkbox"/> Other: _____ |

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Examination of Application #09/

1. Claims 1-17 of application 10/506,708, filed on 7-september-2004, are presented for examination.

Claim Objections

2. Claims 6-17 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim (claims 6, 10-12, 14, 16 and 17) cannot depend from another multiple dependent claim (claim 4). See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

Claim Rejections under 35 U.S.C. § 101

3. 35 U.S.C. 101 reads as follows:
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.
4. Method claims 1-17 are rejected for reciting a process that is not directed to the technological arts. In regard to claim 1, this claim is directed at a method for constructing a roll function for use in designing transition curves for railroad tracks and other vehicle guideways. To be statutory, the utility of an invention must be within the technological arts. *In re Musgrave*, 167 USPQ 280, 289-90 (CCPA, 1970). The definition of "technology" is the "application of science and engineering to the development of machines and procedures in order to enhance or improve human conditions, or at least to improve human efficiency in some respect." (Computer Dictionary 384 (Microsoft Press, 2d ed.1994)). The limitations recited in claim 1 contain no

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language suggesting that claim 1 is intended to be within the technological arts. However, please note the method steps of claim 1 recited as part of a "computer-implemented method" would be considered as directed to the technological arts.

5. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention claims (claim 1 preamble), *"A method for constructing a roll function for use in designing transition curves for railroad tracks and other vehicle guideways."*

5.1 The Manual Patent Examining Procedure (hereinafter MPEP) provides guidelines, in Section 2106(IV)(B)(2)(b), that to be statutory, the invention must be analyzed in view of whether or not it can be classified as a series of steps to be performed on a computer, wherein the steps of the process are evaluated to determine if they perform Independent Physical Acts or Manipulate Data Representing Physical Objects or Activities, in order to achieve a practical application with a useful, concrete and tangible result; and if not, does the invention merely manipulate an abstract idea or solve a purely mathematical problem without any limitation to a practical application.

MPEP Section 2106(IV)(B)(2)(b)(I) further provides that, in regard to Independent Physical Acts (Post-Computer Process Activity), a process is statutory if it requires physical acts to be performed outside the computer independent of and following the steps to be performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure. Furthermore, the

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Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity) defines a statutory process as one that requires the measurements of physical objects or activities to be transformed outside of the computer into computer data, where the data comprises signals corresponding to physical objects or activities external to the computer system, and where the process causes a physical transformation of the signals which are intangible representations of the physical objects or activities.

5.2 In view of the foregoing, and other considerations, the Examiner respectfully contends that the claims of the present invention do not meet the criteria established above for a statutory process. The reasoning behind this determination is:

5.3 The claimed invention, "*A method for constructing a roll function for use in designing transition curves for railroad tracks and other vehicle guideways*", does not require physical acts to be performed outside the computer, those acts being independent of and following the steps to be performed by the computer, those acts further involving the manipulation of tangible physical objects which result in the object having a different physical attribute or structure. For this reason, the claimed invention does not meet the Independent Physical Acts (Post-Computer Process Activity) requirement.

5.4 Further, the Examiner respectfully contends that the claims fail to require measurements of physical objects to be transformed outside of the computer into computer data; and thereby do not meet the Manipulation of Data Representing Physical Objects or Activities (Pre-Computer Process Activity) requirement.

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5.5 MPEP Section 2106(IV)(B)(2)(b)(ii) provides that a statutory computer process is determined not by how the computer performs the process, but by what the computer does to achieve a practical application with a useful, concrete and tangible result. For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory, while a claimed process for digitally filtering noise employing the mathematical algorithm is statutory. The long line of cases in this area that are referred to in MPEP Section 2106(IV)(B)(2)(b)(ii) exemplify this requirement, by utilizing in the claim language, terms such as controlling, executing, changing and removing. In view of the aforementioned requirement, the Examiner respectfully contends that the claim language does not claim a practical application, that language claiming (in claim 1 for example): defining a set of basic roll functions; constructing the roll function as a linear combination; and treating coefficients of a individual basic roll function as parameters of the roll function.

5.6 For at least these reasons, the Examiner respectfully posits that the claims of the present invention do not meet the criteria for a statutory process. Accordingly, the *method for constructing a roll function for use in designing transition curves for railroad tracks and other vehicle guideways*, is determined to be a method consisting solely of mathematical operations, converting one set of numbers (the set of basic roll functions) into another set of numbers (the parameters of the roll function), whereby the method does not manipulate appropriate subject matter, and thus cannot constitute a statutory process (MPEP Section 2106(IV)(B)(2)(c)).

Allowed Claims

6. Claims 1-17 are deemed by the Examiner to be allowable over the prior art of record at

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this time, pending resolution of the 101 rejections noted above.

Response Guidelines

7. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

7.1 Any response to the Examiner in regard to this non-final action should be

directed to: Russell Frejd, telephone number (571) 272-3779, Monday-Friday from 0530 to 1400 ET, **or** the examiner's supervisor, Jean Homere, telephone number (571) 272-3780. Inquires of a general nature or relating to the status of this application should be directed to the TC2100 Group Receptionist (571) 272-2100.

mailed to: Commissioner of Patents and Trademarks
P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to: (571) 273-8300

Hand-delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

Date: 19-September-2005

RUSSELL FREJD

**RUSSELL FREJD
PRIMARY EXAMINER**